

IV. REMARKS

Status of the Claims

Claims 1 and 7 are amended, claims 5,6,8-10,12,13, and 15 are canceled, and claims 16 and 17 are added. Claims 1-4,7,11 and 14, 16, and 17 are presented for further consideration.

Summary of the Office Action

Claims 1-8, and 10 and 12 stand rejected under 35USC102(e) on the basis of the cited reference England, U.S. Patent No. 6,483,445. Claim 9 stands rejected under 35USC103(a) on the basis of the cited reference England. Claim 11 stands rejected under 35USC103(a) on the basis of the cited reference England in view of the cited reference Grant, U.S. Patent No. 5,339,097. Claim 13 stands rejected under 35USC103(a) on the basis of the cited reference England in view of the cited reference Moon, U.S. Patent No. 6,275,376. Claim 14 stands rejected under 35USC103(a) on the basis of the cited reference England in view of the cited reference Lichtenberg, U.S. Patent No. 5,336,001. Claim 15 stands rejected under 35USC103(a) on the basis of the cited reference England in view of the cited reference Moon, and further in view of the cited reference Jahagirdar, U.S. Patent No. 6,125,286. In addition, claim 15 stands rejected under 35USC112(a). The Examiner is respectfully requested to reconsider his rejection in view of the following remarks.

The Examiners objections to the claims are noted and amendments have been made to those claims remaining in response to the objections.

The Invention

As defined in independent claim 1, as amended, this application is directed to a user interface in an electronic device for use in multiple applications for example mobile communications and text processing. The body of the device has an upper surface upon which is mounted a display panel which is slidable between two positions one in which it covers a portion of the upper surface and another in which it extends outward from the upper surface. A text keyboard is installed in the upper surface in the general area covered by the display panel in its cover position. This keyboard is used in association with a first application, for example a personal information manager. Auxiliary button decks are arranged on the upper surface on either side of the display panel. One of these decks provides a user interface for a second application, for example, a mobile phone. The panel contains one display and is movable so that it can be reversed wherein the display faces the keyboard in the cover position. This protects the display when not in use. The system of the cited reference England does not disclose a device having the features, as described in claim 1 of this application.

Discussion of the Cited References

The Examiner relies primarily on the reference England in support of his rejections. The reference England fails to disclose a sliding display panel which maybe reversed so that the display faces the keyboard. Further the reference England fails to disclose a device used for multiple applications, i.e., it is described only in personal digital assistants and the like. Also, inspite of the Examiner's characterization to the contrary, England has only a single side deck. Further the device of England has no window that provides visibility of the display

from the bottom when the panel is reversed.

The Examiner appears to have misunderstood the disclosure of this application with respect to the viewing of the display from the bottom of the device. As described in claim 15, a window is constructed in the body and extends through to the bottom surface of the body to enable at least a portion of the display to be viewed from the bottom, when the panel is reversed. There is no second display mentioned in the application, the only display that can be viewed through the window 15 is display 2 which faces the recessed surface when the panel is reversed. The reference in the application indicates that the display 6 on screen 2 may be viewable through bottom window 15 to enable the viewing of caller i.d. or "other display content". Such display content is only available on display 6 of screen 2. There is no second display.

The Examiner has also cited the reference Grant as disclosing a circular array of keys. These keys are used in association with the command keys of a computer keyboard and not with respect to a mobile telephone interface. The reference Grant does not remedy the many deficiencies of the primary reference England.

The Examiner further cites an incidental background disclosure in the reference Moon, that indicates that portable computer displays often pivot between open to closed positions. It says nothing about combining sliding and pivot motion to provide a reversible display panel. The reference Grant does not remedy the many deficiencies of the primary reference England.

The citation of the disclosure of Jahagirdar is not pertinent to this invention as it shows a secondary display on one side of a mobile phone for displaying auxiliary information. As discussed

above, this is not the same as viewing a single display through the viewing window of this invention.

The cited reference Lichtenberg relates to a QWERTY style computer keyboard in which the right and left key arrays are canted on an angle towards each other. This does not disclose a communication keypad for mobile phone that is arranged at a 45° angle to facilitate single handed use of a mobile phone. This reference does not remedy the deficiencies of the cited reference England.

The Issue of Anticipation

It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221).

"...it must be shown that the reference contains all of the elements of the claims apart from irrelevant or merely extraneous variations, and the elements are arranged in the same way to achieve the same result which is asserted to be an inventive function..." 454 U.S. 1129 (1981)

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement analysis. If the device described in the cited reference would not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this standard to the device of the reference England it becomes clear that England is missing significant elements of independent claim 1 as amended. These missing elements are listed above.

Since these elements form no part of the device of England, there would be no infringement if England was later, therefore, the cited reference England no longer can support the rejection by the Examiner based on anticipation.

The above arguments are equally applicable to the rejected dependent claims still under consideration.

The Issue of Obviousness

Applicant submits that the proposed combination of prior art devices is beyond what is contemplated under the statute. In further support of the above, the examiner's attention is directed to the holdings in ACS Hospital Systems, Inc. v. Mortifiore Hospital et al 221 U.S.P.Q. 929,933 (CAFC 1984), namely that: "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." The same court held similarly on another occasion: "The lesson of this case [In re Imperator, 179 U.S.P.Q. 730 (CCPA 1973)] appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." In re Sernaker, 217 U.S.P.Q. 1, (CAFC 1983). In short to "imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303,312 (CAFC 1983).

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual

determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:


"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Applicant submits that in view of the amendments to the claims, and the above described deficiencies of the cited references, the rejection based on obviousness is not supported by the cited art.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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